

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE



In re Application of:

Elaine S. MASON

Application No.: 09/805,631

Examiner: Liversedge, J.

Filed: March 14, 2001

Group Art Unit: 3628

Customer No.: 25537

Attorney Docket No.: COS99041

Client Docket No.: 09710-1066

For: DISALLOW PAYMENT FOR E-BILLING SYSTEM

Commissioner for Patents  
Alexandria, VA 22313-1450**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Dear Sir:

Applicants respectfully request a pre-appeal brief review be made of the present application for at the least the following clear errors.

**I. THE OFFICE ACTION OVERLOOKS THE FEATURES OF "DETERMINING WHETHER THE INVOICE AMOUNT IS A ZERO BALANCE OR A CREDIT BALANCE" AND "GENERATING A DISALLOW PAYMENT MESSAGE BASED UPON THE DETERMINING STEP"**

For example, claim 1 is as follows with added emphasis:

1. A method for providing an on-line billing system, the method comprising:

retrieving invoice information corresponding to a customer;

displaying the invoice amount via a web browser;

receiving an input to initiate payment corresponding to the invoice amount;

**determining whether the invoice amount is a zero balance or a credit balance; and**

**selectively terminating the payment and generating a disallow payment message based upon the determining step.**

Applicants maintain that the above features (i.e., determining step and generating step) are not individually taught. Moreover, even if the reference of *McNair* can be contorted to disclose these features individually, the claimed steps bear no relationship in the context of the entirety of the claim (e.g., **"based upon the determining step"**).

The Examiner cites to paragraph [0048] of *McNair* for a supposed teaching of the determining step, and paragraphs [0055] and [0056]. For convenience, these passages (along with paragraph [0054]) are provided as follows (Emphasis Added).

[0048] A CPU 13 (central processing unit) of the payee accumulates an account information 14. Account information 14 is comprised of the payer's account number 16 with the payee and phone number 21 of the payee. **CPU 13 also accumulates the payer's recent financial activity 22 up to the statement closing date 24. Activity 22 is comprised of new purchases 25, finance charges 26, new balance 28, and time bounding such as closing date 24 and payment due date 30.** CPU 13 processes instructions to a word processor 32, which formats and sends them to an alphanumeric printer 34. Processor 32 causes printer 34 to print account information 14 and activity 22 on a sheet of paper 36 as alphanumeric information 38. CPU 13 is also programmed to encode the data into a barcode processing instruction 40. Generally, barcode printers have the ability to encode data into barcode images. If printer 34 is limited to alphanumerical characters, then processing instruction 40 causes a barcode printer 44 to add symbol 42 in the top margin of the paper 36. If printer 34, for example a laser printer, has the ability to print characters other than alphanumerical, CPU 13 will encode information 14 and activity 22 into processing instruction 40a. Command 41 causes printer 34 to print account information 14 and activity 22 as a symbol 42 in the top margin of the paper 36.

[0054] A control instructions editor 54 has been installed in PC 52. Editor 54 processes signal 50. Editor 54 is programmed to determine if access code 13 is present in signal 50. If access code 13 is present in signal 50, editor 54 will automatically integrate account information 14 and activity 22 into editor 54. **Editor 54 enables the payer to interface with image 60 utilizing user data entry such as a mouse 66 and a keyboard 67.** Image 60 follows the same format of alphanumeric information 38 so that the payer can easily compare image 60 with account information 14 and activity 22 to feel comfortable using editor 54 for payment transaction instructions.

[0055] A "NEXT" button 64 is located on the lower right corner of image 60. Clicking "NEXT" button 64 with mouse 66 causes a transaction display 68 to appear on terminal 62 as shown in FIG. 7. Since the payee allows installment

payments, the payee offers the payer choices of clicking a button 70 labeled "Pay (minimum) amount of \$54.43", a button 72 labeled "Pay (intermediate amount) \$\_\_\_\_", or a button 74 labeled "Pay new balance of \$1,187.46".

[0056] **Editor 54 polices for input errors.** Buttons 70, 72, and 74 are mutually exclusive and mouse 66 must click one of them. If mouse 66 clicks button 72, an amount between \$54.43 and \$1,187.46 must be entered in the blank space prior to proceeding further. **If "NEXT" button 64 is clicked without transaction display 68 being properly filled out, a conventional error message (not shown) will appear.** The payer has clicked button 72 to pay the intermediate amount of \$200.00 by and using keyboard 67 to enter 200.00 in the space provided.

Scrutiny of paragraph [0048] reveals that no **determination** of a zero balance or credit balance is made by the CPU 13. Instead, the CPU 13 accumulates financial activities 22, including the new balance 28.

Despite the shortcomings of *McNair*, the Examiner concludes that because the *McNair* system allows for the making of payments, the system necessarily determines that there is a zero balance, in that no payment may be made (Advisory Action, page 2). The Examiner appears to be relying on the theory of inherency, as clearly there is no explicit disclosure of the claimed determining step. The Federal Circuit has clearly mandated that, "the extrinsic evidence 'must make clear that the missing descriptive matter is **necessarily present** in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, **may not be established by probabilities or possibilities**. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (emphasis added); *accord* MPEP § 2163.07(a).

Even assuming, *arguendo*, that the *McNair* system determines a zero balance or a credit balance, such determination has no correlation to the conventional error message that the Examiner presumes to be the claimed disallow payment message. As disclosed in paragraph [0056], the error message of the *McNair* system pertains to "input errors." Specifically, the

above passages simply describe the capability of the editor 54, as an interface for the payer, to generate a “conventional error message” for input errors; such errors stem from clicking the “NEXT” button without entering the proper input. The *McNair* system’s error message is not a “disallow payment” message, in that the error message pertains to an input error – i.e., the conventional error message is triggered when the transaction display 68 is not properly filled out. Such error message has no relevance to disallowing payment. Under the Examiner’s analysis, the claimed language “**based upon the determining step,**” is simply dismissed.

Thus, a *prima facie* of obviousness thus has not been established. To establish *prima facie* obviousness of a claimed invention, all of the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). All words in a claim must be considered in judging the patentability of that claim against the prior art. *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). In the case at hand, the Examiner has not considered all words in the claim by ignoring “**based upon the determining step.**”

## **II. THE OFFICE ACTION OVERLOOKS THE FEATURE OF “WHEREIN THE DETERMINING STEP COMPRISES: APPLYING BUSINESS RULES IN REAL-TIME”**

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For example, claims 2 and 3 recite “wherein the determining step comprises: applying **business rules** in real-time.” The Examiner continues to gloss over the claim terms “business rules,” without providing any factual support in the applied references. For example, in the Advisory Action, the Examiner merely states “[t]hese determining steps are made in real-time and are business rules in that the rules determine whether or not to accept the input transaction based on the account balance.” First, the claims further define that the determination of the zero balance or the credit balance comprises “applying **business rules** in real-time,” not “whether or

not to accept the input transaction.” Second, the Examiner presupposes that any decision process utilizes business rules; this is not supported in the references.

### III. CONCLUSION

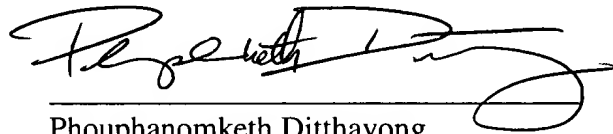
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For the foregoing reasons, the Appeal Brief Panel is respectfully requested to withdraw the rejection of the present application in light of these clear errors and allow the pending claims.

Respectfully Submitted,

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9/11/06  
Date

  
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